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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/529,255 | 04/11/2000 | TAKANORI SHINOKI | 2000-0465A | 5270 |

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EXAMINER

GUARRIELLO, JOHN J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1771

DATE MAILED: 11/05/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/529255

Applicant(s)

Shiraki et al

Examiner

John Guarnello

Group Art Unit

2991

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 8/30/2002
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 9-18 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 9-11, 17, 18 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

15. The Examiner acknowledges paper # 9 of 8/30/2002.
16. The Examiner acknowledges the cancellation of original claims 1-8, and the submission of new claims 9-18, as well as the affirmation of the election of Group I, claims 9-11, 17, 18 drawn to a support member for a semipermeable membrane.

Election/Restriction

17. Group II, claim(s) 12-16, drawn to process of making a support member for a semipermeable membrane, is withdrawn as to the non-elected invention.

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 9, 17, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by JP-10-174849.

JP'849 describes an ultra filtration apparatus comprising a pair of ultra filtration membranes attached to both sides of a metal plastic support plate, (see abstract). JP'849 describes a permeation water passage layer (corresponding to a support member) made up of a non-woven fabric which is interposed between the support plate and each filtration membrane, (see abstract). JP'849 describes the density of the non-woven is 0.4-0.95 g/cc., (see abstract;[0006] of the machine translation). JP'849 describes the tensile strength and the permeability of the permeability layer is restricted to 3-20 kg/15mm width and 5-20 cubic cm./square cm./second, (see abstract; [0006] of machine translation). JP'849 describes the non-woven to be polyester, [0007] and a support component, [0009], (see machine translation). JP'849 describes the essential limitations of the claimed invention, other properties would be inherent. Claims lack novelty.

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Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 9-11, 17, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-10-174849.

JP'849 describes as above in paragraph # 18 except JP'849 describes a component which can be considered a support member or the support member for a semi-permeable membrane except for the particular amount of polyester non-woven, and the parameters as claimed. Since applicant's "comprising" is open language and does not exclude any additional elements. Further, any properties or characteristics inherent in the prior art, although unobserved or detected by the reference, would still anticipate the claimed invention. See *In re Swinehart*, 169 USPQ 226. "It is elementary that the mere recitation of a newly discovered ...property, inherently possessed by things in the prior art

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does not cause claim drawn to those things to distinguish over the prior art".

Since the claimed parameters are expressed differently, and thus may be distinct from those claimed, it is incumbent upon applicants to establish that they are in fact different, and whether such difference is unobvious. It would be obvious to one of ordinary skill in the art at the time the invention was made to employ the particular elements and/or parameters as claimed, since it is well established that merely selecting proportions and ranges is not patentable absent a showing of criticality. In re Beckett 33USPQ 33(CCPA 1937). In re Russell, 439 F.2d 1228, 169 USPQ 426 (CCPA 1971).

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Guarriello whose telephone number is 703-308-3209. The examiner can normally be reached on Monday to Friday from 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The

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fax phone number for the organization where this application or proceeding is assigned is 703-305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

John J. Guarriello:gj

Patent Examiner

October 22, 2002



TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700